



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/633,365

08/07/2000

Bart Alan Meltzer

OIN 1006-2

3951

22470 7590 04/29/2008  
HAYNES BEFFEL & WOLFELD LLP  
P O BOX 366  
HALF MOON BAY, CA 94019

EXAMINER

COULTER, KENNETH R

ART UNIT

PAPER NUMBER

2141

MAIL DATE

DELIVERY MODE

04/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/633,365	<b>Applicant(s)</b> MELTZER ET AL.	
	<b>Examiner</b> Kenneth R. Coulter	<b>Art Unit</b> 2141	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007 (RCE filed).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 48-91 is/are pending in the application.
- 4a) Of the above claim(s) 76-83,90 and 91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-75 and 84-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 48 – 75 and 84 – 89, drawn to remote data accessing, classified in class 709, subclass 217.
- II. Claims 76 – 83, drawn to structured documents, classified in class 715, subclass 234.
- III. Claims 90 and 91, drawn to routing, classified in class 709, subclass 238.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are unrelated.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Ernest J. Beffel, Jr. (Reg. No. 43,489) on 3/29/08 a provisional election was made with traverse to prosecute the invention of Group I, claims 48 – 75 and 84 – 89. Affirmation of this election must be made by applicant in replying to this Office action. Claims 76 – 83, 90, and 91 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 48 – 58, 70 – 75, and 84 – 89 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claims 48, 54, 70, 84, and 89 are directed to methods that can be interpreted as programs.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Tangible hardware can be added to these independent claims in order to overcome the 35 USC 101 rejection.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 48 – 75 are rejected under 35 U.S.C. 102(b) as being anticipated by “Guidelines for using XML for Electronic Data Interchange”; Version 0.02; Editor: Martin Bryan, The SGML Centre; September 12, 1997. (hereafter Bryan).

2.1 Regarding claim 48, Bryan discloses a method for establishing transactions among trading partners in a network, comprising:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered (p. 8 – 10 “Repositories”; pp. 3, 4 “Definitions for XML/EDI”); and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners (pp. 3, 4, 8 – 10); and

providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node (pp. 3, 4, 8 – 11).

2.2 Per claim 49, Bryan teaches that said machine-readable specifications comprises data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units (pp. 5 “pointer”).

2.3 Regarding claim 50, Bryan discloses that said machine-readable specifications included data adapted for parsing to identify an input document and one or more transactions which accept said input document (pp. 12 “XML parser”).

2.4 Per claim 51, Bryan teaches that the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units (pp. 13 – 14 “Developing DTDs”).

2.5 Regarding claim 52, Bryan discloses that the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to definitions of input and output documents for the particular transaction (pp. 13 – 14).



Art Unit: 2141

2.6 Per claim 53, Bryan teaches that the storage units comprise parsed data (pp. 12 – 14).

2.7 Regarding claim 57, Bryan discloses that the storage units comprise unparsed data (pp. 12 – 14).

2.8 Per claim 58, Bryan teaches associating trading partners with said machine readable specifications (pp. 12 – 14).

2.9 Regarding claims 54 – 56 and 59 – 75, the rejection of claims 48 – 53, 57, and 58 (paragraphs 2.1 – 2.8 above) under 35 USC 102(b) applies fully.

In addition, Bryan discloses:

character data encoding text characters in the one of the input and output documents (pp. 2 – 3); and

markup data identifying sets of storage units according to the logical structure of the input and output documents (pp. 2 – 3 “XML”).

3. Claims 48 – 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Olsen et al. (WO 98/33125) (Designates the US; printed in English).

3.1 Regarding claim 48, Olsen discloses a method for establishing transactions among trading partners in a network, comprising:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered (Abstract “maintaining shared, automated business processes across distributed organizations”; Figs 1; Fig. 4, items 410, 460, 470; p. 3, line 26 – p. 4, line 1; p. 4, lines 11 – 21; pp. 11 – 12 ); and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners (p. 9, lines 3 – 9); and

providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node (Abstract; Fig. 1; p. 3, line 26 – p. 4, line 1; p. 4, lines 11 – 21; p. 9, lines 3 – 9).

3.2 Per claim 49, Olsen teaches that said machine-readable specifications comprises data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 1, 4; p. 3, line 26 – p. 4, line 1; p. 4, lines 11 – 21; p. 9, lines 3 – 9).

3.3 Regarding claim 50, Olsen discloses that said machine-readable specifications included data adapted for parsing to identify an input document and one or more transactions which accept said input document (Abstract; Figs. 1, 3, 4; p. 10, line 21 – p. 11, line 16).

3.4 Per claim 51, Olsen teaches that the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 1, 3, 4; p. 10, line 21 – p. 11, line 16; p. 9, lines 3 – 9).

3.5 Regarding claim 52, Olsen discloses that the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to definitions of input and output documents for the particular transaction (Abstract; Figs. 1, 3, 4; p. 9, lines 3 – 9).

3.6 Per claim 53, Olsen teaches that the storage units comprise parsed data (Abstract; Figs. 1, 3, 4; p. 9, lines 3 – 9).

3.7 Regarding claim 57, Olsen discloses that the storage units comprise unparsed data (Abstract; Figs. 1, 3, 4; p. 9, lines 3 – 9).

3.8 Per claim 58, Olsen teaches associating trading partners with said machine readable specifications (Abstract; Fig. 1; p. 3, line 26 – p. 4, line 1; p. 4, lines 11 – 21; p. 9, lines 3 – 9).

Art Unit: 2141

3.9 Regarding claims 54 – 56 and 59 – 75, the rejection of claims 48 – 53, 57, and 58 (paragraphs 3.1 – 3.8 above) under 35 USC 102(e) applies fully.

In addition, Olsen discloses:

character data encoding text characters in the one of the input and output documents (p. 9, lines 3 – 9); and

markup data identifying sets of storage units according to the logical structure of the input and output documents (p. 9, lines 3 – 9).

4. Claims 48 – 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Hogan et al. (U.S. Pat. No. 5,778,368) (Real-Time Embedded Software Repository with Attribute Searching Apparatus and Method)

4.1 Regarding claim 48, Hogan discloses a method for establishing transactions among trading partners in a network, comprising:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered (Abstract; Figs. 1, 2, 4, 10; col. 8, lines 26 – 42; col. 10, lines 46 – 67; col. 13, lines 10 – 39; col. 7, lines 47 – 50 “meta-data”); and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners (Fig. 10; col. 19, lines 19 – 65); and

providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node (Abstract; Figs. 1, 2, 10; col. 8, lines 26 – 42).

4.2 Per claim 49, Hogan teaches that said machine-readable specifications comprises data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units (Figs. 1, 2, 10; col. 10, lines 54 – 67).

4.3 Regarding claim 50, Hogan discloses that said machine-readable specifications included data adapted for parsing to identify an input document and one or more transactions which accept said input document (col. 8, lines 26 – 42; col. 10, lines 46 – 67; col. 13, lines 10 – 39).

4.4 Per claim 51, Hogan teaches that the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units (Figs. 1, 2, 10; col. 10, lines 54 – 67).

4.5 Regarding claim 52, Hogan discloses that the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to definitions of input and output documents for the particular transaction (col. 8, lines 26 – 42; col. 10, lines 46 – 67; col. 13, lines 10 – 39).

4.6 Per claim 53, Hogan teaches that the storage units comprise parsed data (col. 8, lines 26 – 42; col. 10, lines 46 – 67; col. 13, lines 10 – 39).

4.7 Regarding claim 57, Hogan discloses that the storage units comprise unparsed data (col. 8, lines 26 – 42; col. 10, lines 46 – 67; col. 13, lines 10 – 39).

4.8 Per claim 58, Hogan teaches associating trading partners with said machine readable specifications (Abstract; Figs. 1, 2, 4, 10; col. 8, lines 26 – 42; col. 10, lines 46 – 67; col. 13, lines 10 – 39).

4.9 Regarding claims 54 – 56 and 59 – 75, the rejection of claims 48 – 53, 57, and 58 (paragraphs 4.1 – 4.8 above) under 35 USC 102(e) applies fully.

In addition, Hogan discloses:

character data encoding text characters in the one of the input and output documents (Figs. 1, 2, 10; col. 10, lines 54 – 67); and

markup data identifying sets of storage units according to the logical structure of the input and output documents (col. 8, lines 26 – 42; col. 10, lines 46 – 67; col. 13, lines 10 – 39).

5. Claims 48 – 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Baker et al. (U.S. Pat. No. 6,338,067) (Product/Service Hierarchy Database for Market Competition and Investment Analysis)

5.1 Regarding claim 48, Baker discloses a method for establishing transactions among trading partners in a network, comprising:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14); and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14); and

providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14).

5.2 Per claim 49, Baker teaches that said machine-readable specifications comprises data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 5, 6; col. 10, lines 34 – 45).

5.3 Regarding claim 50, Baker discloses that said machine-readable specifications included data adapted for parsing to identify an input document and one or more

Art Unit: 2141

transactions which accept said input document (col. 12, lines 6 – 14; col. 14, lines 52 – 56).

5.4 Per claim 51, Baker teaches that the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14).

5.5 Regarding claim 52, Baker discloses that the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to definitions of input and output documents for the particular transaction (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14).

5.6 Per claim 53, Baker teaches that the storage units comprise parsed data (col. 12, lines 6 – 14; col. 14, lines 52 – 56).

5.7 Regarding claim 57, Baker discloses that the storage units comprise unparsed data (col. 12, lines 6 – 14; col. 14, lines 52 – 56).

5.8 Per claim 58, Baker teaches associating trading partners with said machine readable specifications (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14).



Art Unit: 2141

5.9 Regarding claims 54 – 56 and 59 – 75, the rejection of claims 48 – 53, 57, and 58 (paragraphs 5.1 – 5.8 above) under 35 USC 102(e) applies fully.

In addition, Baker discloses:

character data encoding text characters in the one of the input and output documents (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14); and

markup data identifying sets of storage units according to the logical structure of the input and output documents (Abstract; Figs. 1, 2, 6; col. 12, lines 6 – 14).

### ***Response to Arguments***

6. Applicant's arguments filed 10/31/07 have been fully considered but they are not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/  
Primary Examiner, Art Unit 2141

krc